

REMARKS

The present application is a reissue application of U.S. Patent 6,001,614 which issued on December 14, 1999 from U.S. Patent Application 09/241,353. Claims 1-29 are currently pending including claims 1-23 in the patent and newly added claims 24-29. Claims 1 and 23 have been amended.

Statement of Support 37 CFR 1.173(c)

Independent claims 1 and 23 have been amended in regard to the definition of the size of the sets of oligonucleotide 5'-monophosphates. Applicant seeks to use the definition found in the specification at column 4, line 24-25. At the time the claims were amended during prosecution, under the law prevailing at that time, Applicant did not think that issuance of the claims in the form present in the '614 patent would result in a complete bar to covering the use of oligonucleotide 5'-monophosphates having more than 10 bases. This belief is reflected in a statement found in an amendment in the patent file styled "Second Supplemental Amendment Under 37 CFR §1.115"

"It is noted that the upper size of oligonucleotides claimed is 10 bases, the specification describes a size range of 2 to about 10. It is Applicant's position that the size difference between primer and oligonucleotide is more important. One of ordinary skill in the art will recognize the ability to make minor changes in the size of primers or oligonucleotides to be outside the precise size ranges stated in the

claims without departing from the meaning of the claims as long as a significant size difference is maintained between primer and oligonucleotide."

Recent changes in the law now call that belief into question. Applicants point out that it was not strictly necessary to include the limitation of "not more than 10 bases" or the "consisting" language to distinguish the claims from the prior art of record, particularly U.S. Patent 5,888,731 to Yager and U.S. Patent 5,403,708 to Brennan as applied by the Examiner. Applicant is not attempting to now claim subject matter which was given up during prosecution.

New claims 24-29 are directed to additional embodiments and rely on a concept not previously claimed but clearly disclosed in the specification at e.g. column 11, line 41 to column 12, line 6. Each of the new independent claims tracks the language of the original independent claims except with respect to the lengths of the primer and oligonucleotides. It is clear from this passage and the numerous worked examples that an essential feature of the methods is that there be a significant size difference, in base length, between primers and the oligonucleotide 5'-monophosphates. The new claims differ from the issued claims in specifying a length difference between the primers and the oligonucleotide 5'-monophosphate even though embodiments encompassing that length difference were claimed in the patent. Applicant

believes he erred in claiming less than what he had a right to claim by not presenting claims describing this essential relationship.

Because this is an application for a Reissue patent, all changes in the claims are indicated in the patent. Therefore, changes to the patent claims are not presented in the normal amendment style with both clean and marked-up versions of the amended claims. Applicants asked to be advised if the form of this amendment is improper.

It is believed that the Claims as presented are allowable. A first Office Action on the merits is respectfully requested.



Richard S. Handley, Ph.D.

Registration No. 38,484

December 12, 2001